

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application and for courtesies extended during the Examiner Interview conducted on September 4, 2007.

Disposition of Claims

Claims 1-26 are currently pending in this application. Claims 1, 19, 20, 22, and 24 are independent. The remaining claims depend, directly or indirectly, from claims 1, 20, 22, and 24.

Drawings

Applicants respectfully request that the Examiner indicate whether the drawings filed on July 6, 2001, are accepted.

Claim Amendments

Independent claims 1, 19, 20, 22, and 24 have been amended to clarify the present invention as recited. Specifically, the independent claims have been amended to recite that the user tax profile is stored in a tax profile database and that user tax profile includes actual and forecasted tax data particularized to the user. Applicants assert that no new subject matter is added by way of these amendments. Support for these amendments may be found, for example, in paragraphs [0011], [0024]-[0025], and [0030] of the Specification.

Rejections under 35 U.S.C. § 103

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,161,098 (“Wallman”). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §2143.

If the Examiner does not produce a *prima facie* case, Applicants are under no obligation to submit evidence of non-obviousness. The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicants from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. *See*, MPEP §2142.

Applicants respectfully assert Wallman does not teach or suggest each and every limitation of the amended independent claims. Accordingly, Applicants respectfully assert the Examiner has failed to produce a *prima facie* case.

As discussed with the Examiner during the Examiner Interview of September 4, 2007, the novelty of the present invention lies in the tax profile that is particularized to the user. Because embodiments of the present invention combine tax data for a user from a variety of sources and

store such tax data in accessible form, embodiments of the invention provide a unique database of information that was previously hard to gather and maintain.

The Examiner contends that Wallman teaches determining consequences of an investment transaction to a potential total tax liability of a user. The Examiner further contends that Wallman teaches storing a tax profile containing tax return data for at least one tax year of the user, and states that the stored tax profile containing the tax return data is inherent (*see* Office Action mailed June 20, 2007, page 3). Applicants respectfully disagree with the Examiner. In fact, Applicants respectfully assert the Examiner's inherency argument is flawed.

Wallman teaches computing a tax liability for *a particular transaction or series of transactions* (*i.e.*, selling of stocks/bonds/assets/liabilities) (*see* Wallman, col. 3, ll. 35-37). Wallman clearly states "determining the potential tax consequences that would result from trading various combinations of the plurality of assets/liabilities, in which each of the potential tax consequences represents the potential tax consequence that would result from trading one particular subset of assets/liabilities." Thus, Wallman is focused only on tax consequences resulting from a particular sale of one or more securities.

More importantly, Wallman does not gather, combine, and store tax data for multiple previous tax years for a particular user, such that a total future tax liability can be calculated on the spot for a user based on a proposed transaction or an actual completed transaction. Rather, Wallman only uses information related to the sale of assets/liabilities to compute tax consequences associated with *that sale*. Said another way, Wallman is focused on using information from a *securities transaction* to compute tax liability as it relates solely to that transaction, and not tax

information associated with a *user's overall tax scenario*. In fact, Wallman is completely silent, and therefore cannot teach or suggest, storing forecasted and actual tax data particularized to a user in accessible form in a tax profile associated with the user. The cited portion of Wallman for this limitation of the recited claims merely discloses the use of information stored in tax programs to compare such tax program information to capital assets stored in the database to identify potential tax savings from engaging in a *transaction* involving the capital assets (see Wallman, col 6, ll. 6-12). More importantly, Wallman also fails to teach or suggest using the information stored in the tax programs to compute a user's potential *total* future tax liability, as required by the amended independent claims. At best, Wallman arguably teaches that the tax program information is used to compute the tax consequences associated directly and solely with *the transaction(s)* involving the capital assets without taking into account the overall tax liability of the user (*i.e.*, whether the taxpayer gets a refund or is required to pay additional taxes when filing the future tax return).

As discussed with the Examiner during the Examiner Interview of September 4, 2007, the combining and storing of such robust tax data *in an accessible form* is not something that can be characterized as inherent, because tax professionals view this as something that is lacking in current tax products/software. The Examiner's contention that Wallman teaches a tax profile as required by the amended independent claims of the present application would require mischaracterizing the teachings of Wallman and/or alter the primary mode of operation taught by Wallman to a procedure not even contemplated by Wallman, both of which are improper. *See*, MPEP §2143.03.

Thus, because Wallman does not consider the robust amount of tax data contemplated in the present invention in computing tax liability of a user, it is not possible for Wallman to provide a

user with a *total* future tax liability using a tax profile that includes tax data particularized to a user, as required by the amended independent claims.

In view of the above, the Examiner's rejection of amended independent claims 1, 19, 20, 22, and 24 is unsupported by the art and thus withdrawal of this rejection is respectfully requested. Dependent claims are patentable for at least the same reasons.

Conclusion

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 37202/102001; 990006).

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